

APPLICATION NO.  FIL

09/478,882

01/0

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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TOWNSEND & BANTA  
1225 EYE STREET NW  
SUITE 500  
WASHINGTON DC 20005

ATTORNEY DOCKET NO.

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EXAMINER

DATE MAILED:  PAPER NUMBER

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/478,882	EGAWA ET AL.	
	Examiner Alycia Berman	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 04 April 2001.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 12-16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 11 and 17-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/147,293.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Receipt is acknowledged of the election and amendment filed April 4, 2001.

Claim 11 has been amended. Claims 1-19 are pending.

***Election/Restrictions***

2. Applicant's election without traverse of species (b), thiotaurine, and species (g) a method of treating environmental stress due to automobile exhaust gases by (i) suppressing ultraweak chemiluminescence from the skin in Paper No. 6 is acknowledged.

3. Claims 1-10 and 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 6.

***Information Disclosure Statement***

4. Applicant is reminded of the duty to disclose information material to the claimed invention. See MPEP §2000. It is requested that Applicant file an information disclosure statement listing all relevant prior art that had been cited in either foreign or US applications and any additional relevant prior art known to Applicant.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 17-19 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 17 is vague and indefinite because it is unclear if the suppression of ultraweak chemiluminescence from the skin is due to the environmental stress or the treatment. Is Applicants intent to suppress ultraweak chemiluminescence from the skin or to treat suppression of ultraweak chemiluminescence from the skin?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 11 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,601,806 (806).

US '806 teaches that thiotaurine is an effective antioxidant and is useful in topical compositions. See column 3, lines 5 to 47, column 4, lines 61-63, Example 1 at column 12. See the claims for application to the skin.

Chemiluminescence from the skin is caused by oxidation of skin cells as admitted by Applicants at page 20, lines 11 to 23 and page 26, lines 11-18. It is well known in the art that oxidation of skin cells causes wrinkling or premature aging.

Therefore, applying a composition containing an antioxidant for the purpose of scavenging active oxygen compounds in order to treat or prevent skin damage such as wrinkles or premature aging would inherently suppress ultraweak chemiluminescence as instantly claimed. The problem being treated by the compositions of US '806 is the same type of problem that is being treated by the instantly claimed compositions, skin damage. The cause of that stress does not render the claims patentable. One of ordinary skill in the art would be unable to determine precisely which environmental factors may or may not have caused any damage to the skin.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 11 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,601,806 (806) in combination with the HCAPLUS abstract of Egawa et al., *Cigarette smoke induced lipid peroxidation and its oxidative effect on the skin*, Sci. Conf. Asian Soc. Cosmet. Sci., 3<sup>rd</sup> (1997):271-278.

US '806 teaches all the limitations of the claims as stated above. It does not teach treating environmental stress due to exposure of skin to automobile exhaust gases by suppressing ultraweak chemiluminescence from the skin.

Egawa et al. teaches that human fibroblast cells treated with antioxidants inhibit chemiluminescence in the skin, thereby preventing peroxidation. Egawa et al. discloses thiotaureine.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the antioxidant compositions of US '809 to suppress chemiluminescence from the skin as taught by Egawa et al. expecting to prevent peroxidation of skin cells.

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alycia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-44556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alycia Berman  
Patent Examiner  
May 25, 2001

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600